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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,796	05/12/2005	Peter G. Klimko	2443 US F	1650
26356	7590	05/27/2009		
ALCON IP LEGAL, TB4-8 6201 SOUTH FREEWAY FORT WORTH, TX 76134			EXAMINER FAY, ZOHREH A	
			ART UNIT	PAPER NUMBER
			1612	
			MAIL DATE	DELIVERY MODE
			05/27/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,796

Applicant(s)

KLIMKO ET AL.

Examiner

ZOHREH A. FAY

Art Unit

1612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 4, 2009 has been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malfroy-Caine et al. (U.S. patent 6,046,188) in view of Winkler et al. (Molecular vision 1999).

Malfroy-Camine et al. teach the use of the claim-designated compounds as antioxidants having superoxide dismutase activity. See column 2, lines 22-55. The above reference differs from the claimed invention in the use of the compounds for the treatment of disorders such as macular degeneration, DR, and /or retinal edema. Winkler et al. teach the role of oxidation in relation to macular degeneration, and the effect of superoxide dismutase in preventing oxidative damage. See the abstract. It would have been obvious to a person skilled in the art to use a compound having SOD mimetic activity for the treatment of disorders such as macular degeneration, considering that Winkler et al. teach a correlation between the oxidative damage and macular degeneration and the use of compounds with SOD activity for preventing such damage.

One skilled in the art would have been motivated to combine the teachings of the above references, since one relates to the use of the claimed compounds having SOD activity and the other two relate to the use of compounds with SOD activity for the treatment of macular degeneration, and a correlation between the oxidative damage

and macular degeneration, and the use of compounds with SOD activity for the treatment of such condition. The above references in combination make clear that the claimed compounds are antioxidants having SOD activity. The above references also teach a correlation between oxidative damage and macular degeneration and the use of compounds having SOD activity for prevention of such damage. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 1-3 are properly rejected under 35 U.S.C. 103.

Applicant's arguments and remarks have been carefully considered, but are not deemed to be persuasive. Applicant in his remarks argues that Malfroy-camine et al. do not teach the use of the claimed compounds for the treatment of macular degeneration, retinopathy and retinal edema. The arguments are not well taken. Applicant is reminded that the rejection is an obviousness rejection and not anticipation. Malfroy-Camine et al. is cited to show that claimed compounds as anti-oxidants having superoxide dismutase activity. Applicant also refers to Winkler et al. reference and argues that such reference does not teach that compounds with SOD activity can prevent oxidative damage associated with macular degeneration. Applicant argues that Winkler et al. teach superoxide dismutase and catalase as "the armory of protectants" involved in a reaction which may be involved in the development of oxidative damage which may lead to AMD. The arguments are not well taken. Applicant is reminded that obviousness does not require absolute predictability. Winkler et al. teach the role of oxidation in relation to macular degeneration and suggests that superoxide dismutase may be involved in preventing oxidative damage. Malfroy-

Camine et al. teach that the claimed compounds have superoxide dismutase activity. Therefore, it would have been obvious to use compounds having superoxide dismutase activity for the treatment of AMD motivated by the teaching of Winkler et al., which teaches the effect of superoxide dismutase in preventing oxidative damage. Applicant's arguments regarding De la Paz and Delcourt have been noted. Applicant in his remarks argues that while both articles acknowledge the oxidative mechanism may play a role in the development of AMD, neither of references teach that superoxide can be used to treat macular degeneration. The arguments are not well taken. The fact that the references recognize that superoxide dismutase is involved in protecting against oxidative damage such as that which leads to AMD, is sufficient for a person skilled in the art to use such compounds for the treatment of AMD.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZOHREH A. FAY whose telephone number is (571)272-0573. The examiner can normally be reached on Monday to Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fredrick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ZF
/Zohreh A Fay/
Primary Examiner, Art Unit 1612